

Appl. No. 09/489,310
Docket No. 7922
Customer No. 27752

REMARKS

Claim Status

Claims 23 and 25-31 are pending in the application. Claim 23 has been amended to recite the pH range of Claim 24 (now cancelled as redundant) and to recite the basis for the "in need of" language that relates to the status of the patient's teeth (i.e., acid demineralization). Basis is at page 4, lines 11-19. Claims 25, 28 and 30 have been amended to provide correct dependency. It is submitted that all amendments are fully supported and entry is requested.

Rejections Under 35 USC 103

The claims stand rejected under §103 over US 3,681,091 and the Grunberg article, for reasons given at pages 2-4 of the Office Action.

Applicants respectfully traverse the rejections in view of the claims as now amended.

For the record, all previous arguments in support of patentability continue to apply, but will not be repeated herein for the sake of brevity.

At the outset, it is submitted that it is entirely counter-intuitive and, hence, non-obvious, to use an acidic beverage of the present type to treat teeth that have been eroded by acid.

Moreover, the Examiner's attention is directed to the fact that this is not simply a case of attempting to claim a newly discovered result of a known process. The claimed method for treating dental erosion caused by exposure of the teeth to acid requires a particular patient population and a particular type amount of phosphate agent that is administered to such patient population at an acidic pH, neither of which are explicitly or inherently disclosed by the combination of cited documents.

It is bedrock principle of patent law that new uses of old products or processes are patentable subject matter. *See Perricone v. Medicis Pharm. Corp.*, 432 F.3d 1368, 1378, 77 USPQ2d 1321, 1328 (Fed. Cir. 2005); 35 USC §101 (2000) (identifying as patentable "any new and useful improvements" of a process machine manufacture, etc.). In *Perricone*, the district court had previously held certain claims of Perricone's US Patent No. 5,409,693 ("'693 patent"), directed to methods of treating and preventing skin sunburn, to be inherently anticipated by a prior art reference, Pereira. Pereira disclosed the same compositions for topical application to skin. The district court reasoned that the topical application of Pereira's compositions would necessarily yield the skin benefits claimed in Perricone's patent, stating that the prior art reference "will inherently function in

[the claimed beneficial] manner when topically applied to the skin.” *Perricone v. Medicis Pharm. Corp.*, 267 F.Supp.2d 229, 248 (D. Conn. 2003). On appeal, the Federal Circuit reversed the holding that Pereira anticipated Claims 1-4 and 7 of the ‘693 patent, finding that the district court’s analysis went astray because it assumed what Pereira neither disclosed nor rendered inherent,” and stating:

Pereira is silent about any sunburn prevention or treatment benefits, not to mention the mechanisms underlying such uses. If Pereira did teach sunburn prevention, as well as the mechanism behind that prevention, those teachings might suggest that Dr. Perricone’s sunburn treatment claims would have been obvious. However, those unrealized possibilities do not alter the analysis in this case where Pereira does not disclose topical application to skin sunburn.

Perricone, 432 F.3d at 1379, 77 USPQ2d at 1328. The Court further noted that “the issue is not . . . whether Pereira’s lotion *if applied* to skin sunburn would inherently treat that damage, but whether Pereira discloses the application of its composition to skin sunburn. It does not.” *Id.* At 1378, 77 USPQ2d at 1328 (emphasis in original).

Indeed, if anyone ever corrected tooth erosion by using the ‘091 method, alone or with Grunberg, it could only be considered accidental. It is well-established that an accidental or unwitting duplication of an invention cannot constitute an anticipation. *In re Marshall*, 578 F.2d 301, 304, 198 USPQ 344, 346 (CCPA 1978) (wherein claims drawn to the use of an effective amount of the anesthetic oxethazaine in a weight control process were found patentable over a reference which taught using the same anesthetic to inhibit the release of the hormone gastrin, because nothing in the prior art reference suggested taking oxethazaine to lose weight). *See also Ex Parte Windhorst*, 2008 WL 2856376 at *6-7 (Bd. Pat. App. & Int. 2008) (non-precedential) (stating that “anticipation may not occur if the claim limitations are ‘accidentally or unwittingly produced, whilst the operators were in pursuit of other and different results, without exciting attention and without its even being known what was done or how it had been done.’”) (quoting *Tilghman v. Proctor*, 102 U.S. 707, 711-12 (1880)).

In short, since the cited documents, alone or in combination, do not suggest treating the patient population herein using an acidic, phosphate-containing composition, it is submitted that all

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claims meet the requirements of §103. Reconsideration and withdrawal of the rejections are requested.

In light of the foregoing, early and favorable action in the case is requested.

Respectfully submitted,

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